Paper No. 8
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Aurora Corporation of America

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Serial No. 76/307,547

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Lucy B. Arant of Mitchell Silverberg & Knupp LLP for Aurora Corporation of America.

Michael L. Engel, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

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Before Simms, Cissel and Drost, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 29, 2001, applicant, a corporation organized and existing under the laws of the state of California, applied to register the mark GEL 'N ROLL on the Principal Register for "pens," in Class 16. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the grounds that applicant's mark so resembles five registered marks, all of which are owned by the same entity and all of which are registered for goods which consist of or include pens, that if applicant were to use its mark in connection with these same products, confusion would be likely. The cited registered marks are shown below:

for "writing instruments, namely, pens, pencils, markers, crayons"[1];

GELLY ROLL

for "ballpoint pens"[2]; and for "writing instruments; and stationery items, namely, blank notebooks, stencils, blank journal books, diaries; pads of blank paper, cubes of note paper"[3];

[1] Reg. No. 2,327,375 issued on the Principal Register to Sakura Color Products of America, Inc. on March 7, 2000.
[2] Reg. No. 1,692,910 issued on the Principal Register to the same corporation on June 9, 1992; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.
[3] Reg. No. 2,421,125 issued on the Principal Register to the same corporation on January 16, 2001.

for "writing instruments"[4]; and

for "writing instruments and stationery items, namely, blank notebooks, stencils, blank journal books, diaries; pads of blank paper, cubes of note paper."[5]

The Examining Attorney based the refusal to register on his findings that the marks are similar in sound and appearance and have similar commercial impressions, and that the goods identified in the registrations are identical to the goods with which applicant intends to use the mark it seeks to register.

Applicant responded to the refusal to register with argument that confusion between its mark and the cited registered marks would not be likely because the marks are

[4] Reg. No. 2,497,138 issued on the Principal Register to the same corporation on October 9, 2001.
[5] Reg. No. 2,497,750 issued on the Principal Register to the same corporation on October 16, 2001.

not similar in appearance, pronunciation or meaning. Applicant argued that the distinction between the two marks results from differences in meaning between "jelly roll" and "rock 'n roll," a term with which it intends its mark to create "a connection." In support of the latter argument, applicant submitted copies of dictionary definitions of the term "jelly roll" as "a thin sheet of sponge cake spread with jelly and rolled up"; and of the term "rock and roll" as "popular music usually played on electronically amplified instruments and characterized by a persistent, heavily accented beat, much repetition of simple phrases, and often country, folk and blues elements." [6]

The Examining Attorney was not persuaded by applicant's arguments, and in the second Office Action, he continued and made final the refusal to register. As additional support for the refusal, he submitted copies of excerpts of articles retrieved from the Lexis-Nexis automated database of publications. These excerpts demonstrate that a "gel pen" is a type of pen which uses ink in gel form. This evidence was submitted by the Examining Attorney to show that by using the word "GELLY"

[6] Both definitions are attributed to Mirriam Webster's Ninth New Collegiate Dictionary.

in its marks, the registrant is making a suggestive reference to the fact that its goods are gel pens.

Applicant concurrently filed a Notice of Appeal, a copy of its response to the first Office Action in which the refusal to register was made, and its appeal brief. The Board instituted the appeal and forwarded the application to the Examining Attorney for his brief in accordance with Trademark Rule 2.142(b). The Examining Attorney timely filed his appeal brief, but applicant neither filed a reply brief nor requested an oral hearing before the Board.

Accordingly, we have resolved this appeal based on consideration of the application file and the written arguments of applicant and the Examining Attorney.

The issue presented in this case is whether applicant's mark so resembles the cited registered marks that if applicant were to use the mark it seeks to register in connection with pens, confusion with the registered marks would be likely. We agree with the Examining Attorney that it would, and thus that the refusal to register is well taken.

The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of In re E.I.

DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression and the similarity of the goods. "When marks would appear on virtually identical goods or services, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ 6098, 1700 (Fed. Cir. 1982).

In that each of the registrations lists either "pens," "ball point pens," or "writing instruments," which term includes pens, the goods identified in the registrations are the same as the "pens" with which applicant intends to use the mark it seeks to register. Accordingly, the degree of similarity between the marks necessary to support a conclusion of likely confusion is less than would be the case if the goods were not identical.

The cited registered marks easily meet this level of similarity because each either consists of or is dominated by the term "GELLY ROLL," which is phonetically very similar to applicant's mark, "GEL 'N ROLL."

As we noted above, one of the cited registered marks shows GELLY ROLL in typed form, whereas the others combine this term with various design elements. As is frequently

the case, although we consider the marks in their entireties, we nonetheless recognize that the literal elements in these marks which combine the term with design elements play a much larger role in creating the commercial impression these marks engender.

GELLY ROLL is similar to GEL 'N ROLL. As the Examining Attorney points out, the terms

> sound alike because both marks have three syllables, with an initial syllable GEL and a final syllable ROLL. Although the middle syllables the marks are different, 'en' versus 'ee,' slight differences in the sound of similar marks will not avoid a likelihood of confusion. In re Energy Telecommunications & Electrical Association, 222 USPQ 350 (TTAB 1983). The test for likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. Visual Information Institute, Inc. v. Vicon industries Inc., 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general, rather than specific, impression of marks. Chemtron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537 (TTAB 1979)." (Examining Attorney's brief, pp. 2, 3).

We agree with him that when these marks are evaluated in view of this standard, confusion is likely because the marks create similar commercial impressions. The phonetic similarity would be sufficient by itself. Molenaar Inc. v. Happy Toys Inc., 188 USPQ 469 (TTAB 1975). The suggestive reference to "GEL" only increases the similarity.

Applicant argues that the connotations, and hence the commercial impressions engendered by these marks, differ, and that it selected its mark so that young potential customers would make a connection between GEL ‘N ROLL and “Rock ‘n Roll,” and therefore get the idea that applicant’s pens are as “hip” as popular music. This may well have been applicant’s intention, but even if, when the mark is displayed in printed form, some potential customers were to make the “connection” applicant intended, the phonetic similarity would still be apparent in other circumstances, such as where the goods were ordered or recommended orally, and in these instances, confusion would still be likely because the marks sound so much alike when they are spoken.

Any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant and against the applicant, who has a legal duty to select a mark which is dissimilar to trademarks already in use in the same field of commerce. In re Hyper Shoppes, (Ohio), Inc., 837 F.2d 643, 6 USPQ2d 1025 (Fed. Cir. 1988).

DECISION: The refusal to register under Section 2(d) of the Act is affirmed.